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EXAMINER

GART, MATTHEW S

ART UNIT PAPER NUMBER

3625

DATE MAILED: 08/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|------------------------------------|--|
| Office Action Summary | Application No. 09/755,442 | Applicant(s) ROBB ET AL. | |
| | Examiner Matthew S. Gart | Art Unit 3625 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,6-9,12-14,16,23 and 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 6-9, 12-14, 16 and 23-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Prosecution History Summary

- Claims 3-5, 10-11, 15, 17-22 and 25-29 were cancelled in the instant invention.
- Claims 1-2, 6-9, 12-14, 16 and 23-24 are currently pending in the instant application.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-2, 6-9, 12-14 and 16 are rejected under 35 U.S.C. 112, first paragraph.

Referring to claims 1-2, 6-9, 12-14 and 16. Claim 1 fails to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The step of, "...connecting to a remote web site through existing wireless telephones lines and not by either infrared or separate radio frequency transmission mediums, by a customer using their customer owned conventional personal handheld display device from a location remotely located away from the remote web site," was not disclosed in the specification as originally filed.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-2, 6-9, 12-14, 16 and 23-24 are rejected under 35 U.S.C. 112, first paragraph.

Referring to claims 1-2, 6-9, 12-14, 16 and 23-24. All of the pending claims are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims contain the term "conventional personal handheld display devices," but the term "conventional" is unclear. The specification as originally filed neither provides an adequate definition of the term "conventional," nor assign any special meaning to the term.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 7-9, 12-14 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Showghi (U.S. Patent No. 6,473,739) in view of Pentel (U.S. Patent No. 6,880,750).

Referring to claim 1. Showghi discloses a method of accessing classification information on a system through handheld display devices, until a finite selection point is achieved without inputting any search queries, comprising the steps of:

- Providing a handheld display device that is selected from at least one of a pager, a cell phone, and a PDA (Showghi: column 3, lines 1-5);
- Accessing and viewing a web site having a first main menu page of category headings by a user on the handheld device (Showghi: column 5, lines 40-48, "Major Item Classification Menu **34**");
- First selecting and viewing at least one of the category headings on the first main menu page on the handheld display device (Showghi: Fig. 4, "Major Item Classification Menu **34**, Selection 3");
- Accessing and viewing a second menu page having first subcategory headings from the first selecting step on the handheld display device (Showghi: column 5, lines 40-48, "Drink Menu **36**");

- Second selecting and viewing at least one of the first subcategory headings on the handheld display device (Showghi: Fig. 4, "Drink Menu **36**, Selection 2");
- Accessing and viewing a third menu page having second subcategory headings from the second selecting step on the handheld display device, the second subcategory headings being solely listed in a single vertical column on the third menu page with separate second subcategory headings solely on each line (Showghi: column 5, lines 40-48, "sub-menu **38**");
- Third Selecting and viewing at least one of the second subcategory headings by scrolling down the single vertical column on the third menu page on the handheld display device (Showghi: Fig. 4, "sub-menu **38**, How many 4");
- Repeating accessing and selecting and viewing by solely scrolling down only one single vertical column on each successive menu page on the handheld display device, until the user reaches an end of a menu series to a finite selection list of a classification that is listed in a single vertical column, wherein interaction of the accessing of the first page, the second page, the third page, and the first selecting, the second selecting and the third selecting are navigated on the handheld display device without inputting any search queries (Showghi: Fig. 3a-3d and Fig. 4); and
- Viewing the single column of the finite selection list of the classification by scrolling down the finite selection list on the handheld display device, without the inputting of any search queries (Showghi: column 7, lines 17-34).

Showghi (U.S. Patent No. 6,473,739) claims domestic priority to Provisional application No. 60/131119, filed on April 27, 1999. Provisional application No. 60/131119 does not expressly disclose a method of accessing classification information on a web-based system through a customer owned conventional personal handheld device.

Pentel discloses a method of accessing classification information on a web-based system through a customer owned conventional personal handheld device (Pentel: column 10, lines 10-17).

Pentel further discloses connecting to a remote web site through existing wireless telephone lines and not by either infrared or separate radio frequency transmission mediums, by a customer using their customer owned conventional personal handheld display device from a location remotely away from the remote web site (Pentel: column 3, lines 30-53),

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Showghi to have included the teachings of Pentel because there is a need for a generalized remote ordering device for customer use inside or outside a facility such as a restaurant, auto repair facility, retail store, grocery store, airport or other service facility (Pentel: column 1, line 66 to column 2, line 5).

Referring to claim 2. Showghi further discloses a method of accessing classification information wherein the steps of accessing of the first page, the second page, the third page, and the first selecting, the second selecting and the third selecting

include the user navigating each accessing and selecting step by voice command using the handheld display device (Showghi: column 4, lines 25-37).

Referring to claim 7. Showghi further discloses a method wherein the first subcategory headings include headings for: makes, items, and services (Showghi: Fig. 4).

Referring to claim 8. Showghi further discloses a method of accessing classification information comprising the step of solely listing the first subcategory headings on the second menu page in a single vertical column and selecting from the single vertical column of the first subcategory by scrolling down there through (Showghi: column 5, lines 40-48, "sub-menu 38").

Referring to claim 9. Showghi in view of Pentel discloses a method according to claim 1 as indicated supra. Pentel further discloses a method comprising the step of solely filtering and sorting the finite selection list of the classification into a filtered and sorted list; and viewing the filtered and sorted list, wherein filtering and sorting only occurs at the finite selection (Pentel: column 6, lines 45-56ge 5).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Showghi to have included the teachings of Pentel because there is a need to purchase a variety of items via a single interface (Showghi: column 1, lines 40-46).

Referring to claim 12. Showghi further discloses a method wherein the user is at least one of: a buyer and seller, each user having an interest in at least one of: a good, a make, an item, and a service (Showghi: Fig. 2).

Referring to claim 13. Showghi further discloses a method wherein the classification information includes: advertisements by sellers, each of the sellers listings at least one of: goods, makes, items and services (Showghi: column 8, lines 23-32).

Referring to claim 14. Showghi in view of Pentel discloses a method according to claim 13 as indicated supra. Pentel further discloses a method comprising the step of requesting an unlisted item from the web based system by a buyer-user, the unlisted item being for at least of: a good, a make, an item and a service (Pentel: column 3, lines 54-56, "...designating a place for delivery.").

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Showghi to have included the teachings of Pentel because there is a need to purchase a variety of items via a single interface (Showghi: column 1, lines 40-46).

Referring to claim 23. Claim 23 is rejected under the same rationale as set forth above in claim 1 and 9.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Showghi (U.S. Patent No. 6,473,739) in view of Pentel (U.S. Patent No. 6,880,750) in further view of Bidz (PTO-892, Ref U).

Referring to claim 6. Showghi in view of Pentel discloses a method according to claim 1 as indicated supra. Showghi in view of Pentel does not expressly disclose a method of accessing classification information wherein the category headings include: Headings for: agriculture, aircraft, automobiles, boats, heavy equipment, heavy trucks, industrial, medical, pickup trucks, recreational vehicles, and sport utility vehicles and vans.

Bidz discloses a method of accessing classification information wherein the category headings include: Headings for: agriculture, aircraft, automobiles, boats, heavy equipment, heavy trucks, industrial, medical, pickup trucks, recreational vehicles, and sport utility vehicles and vans (Bidz: page 7).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Showghi in view of Pentel to have included a plurality of headings as taught by Bidz because the inclusion of such headings would have been an obvious matter of design choice in light of the method already disclosed by Showghi in

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view of Pentel. Such modification would not have otherwise affected the method of Showghi in view of Pentel and would have merely represented one of numerous steps that the skilled artisan would have found obvious for the purposes already disclosed by Showghi in view of Pentel. Additionally, applicant has not persuasively demonstrated the criticality of providing these specific headings versus the headings disclosed by Showghi in view of Pentel.

Claim 16 and 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Showghi (U.S. Patent No. 6,473,739) in view of Pentel (U.S. Patent No. 6,880,750) in further view of Wolfe (U.S. Patent No. 6,282,517).

Referring to claim 16. Showghi in view of Pentel discloses a method according to claim 14 as indicated supra. Wolfe discloses instantly notifying the buyer-user when the unlisted item has been placed by a seller-user on the web based system, which matches the unlisted item; and allowing the buyer-user to purchase the unlisted item from the seller-user (Wolfe: column 16, lines 20-45).

It would have been obvious to one of ordinary skill in the art to have provided the method and system of Showghi in view of Pentel to have incorporated a method and system of the type demonstrated by Wolfe in order to submit a purchase request over a computer network and make said purchase request available immediately to a dealer (Wolfe: abstract).

Referring to claim 24. Claims 24 is rejected under the same rationale as set forth above in claims 1, 14 and 16.

Response to Arguments

Applicant's arguments with respect to all the rejected claims have been considered but are moot in view of the new ground(s) of rejection.

The Examiner notes, provisional application No. 60/131119 does provide adequate support for the menu configuration as required by the instant invention. Support for said configuration are found throughout said provisional application, for example, pages 5 through 6.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew S. Gart whose telephone number is 571-273-3955. The examiner can normally be reached on M-F, 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MSG
Primary Examiner
August 21, 2006